

REMARKS

Currently, claims 1-2, 5-8, and 10-12 are pending in this application. The specification has been amended to correct certain obvious typographical errors; in addition, Applicants have amended claims 1 and 12. Applicants submit that no new matter has been added by these amendments. The continued consideration of the pending claims is respectfully requested in light of this amendment and the following remarks.

Applicants wish to thank Examiner Egwim for the courtesies he extended to the undersigned during the telephonic interview on March 29, 2002. During the interview, Examiner Egwim and the undersigned discussed possible claim amendments to place this application in condition for allowance.

Rejection under 35 U.S.C. § 132

The Examiner has objected to the amendment to the specification filed April 6, 2002, as introducing new matter into the disclosure. That amendment replaced the paragraph Gridging pages 36 and 37 to correct a translation error. Specifically the translation did not specify the Applicants' addition of talc to Bionolle #1020. In the Submission under 37 C.F.R. § 1.114 dated December 2, 2002, Applicants submitted a translation of a "Technical Data Sheet" in order to overcome this rejection. However, the Examiner asserts that Applicants have not provided substantial evidence to demonstrate that Bionolle #1020 is not a talc-containing polymer as purchased because the "Technical Data Sheet" does not mention "Bionolle #1020" specifically.

In response to the Examiner's objection, Applicants attach as an Appendix a translation of a web page entitled "Bionolle #1020" from the Study Group on Biodegradable Materials at the University of Hannover in Germany. Applicants submit that this document clearly indicates that Bionolle #1020, as produced by Showa Highpolymer Co. Ltd., is not a talc-containing polymer as sold. Applicants therefore respectfully request that this objection be withdrawn.

Rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

The Examiner rejected claims 1-2, 5-6, 8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,910,545 to Tsai et al. or U.S. Patent No. 5,916,950 to Obuchi et al. In addition, the Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Tsai et al. or Obuchi et al., each independently as applied to claims 1-2, 5-6, 8, and 10-12, in further view of Japanese Laid-Open Patent Application No. 9-41220 to Yamada et al. Applicants respectfully traverse each of these rejections.

In the Amendment of June 14, 2002, Applicants presented a Declaration under 37 C.F.R. § 1.131 with two invention reports, showing that the invention recited in the application pre-dates, and thus removes, Tsai et al. as a reference against the present claims. The invention report dated September 17, 1997, discloses fasteners formed with at least a disperse phase of polylactic acid. The other invention report, dated October 31, 1997, discloses fasteners formed with at least a dispersed phase of an inorganic filler. The Declaration then gives a clear explanation of both invention reports and points out exactly what facts are established and relied on by the Applicants.

However, the Examiner found this submission unconvincing and stated that a single invention report must include the combination of each and every limitation recited in independent claims 1 or 12 to be persuasive.

Applicants respectfully submit that an invention report need not disclose each and every claim limitation to be persuasive. MPEP § 715.07 states that "when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and 'notes.' An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." Thus, the Applicants may properly rely on both invention reports to overcome Tsai et al. because the evidence presented, in its entirety, shows that the limitations of independent claims 1 and 12 pre-date the reference. In addition, the declaration itself recites a specific and clear explanation of what each invention report establishes; therefore, any missing limitation from an invention report is in fact provided by the declaration. See *In re Borkowski*, 1845 U.S.P.Q. 29 (C.C.P.A. 1974). Applicants submit that the Declaration and invention reports previously submitted properly and persuasively prove that the pending application pre-dates Tsai et al. as a reference. Applicants respectfully request the withdrawal of this rejection.

The Examiner asserts that the tying materials disclosed by Obuchu et al. either anticipate or render obvious the fastener components of the pending claims. Applicants have herein amended independent claims 1 and 12 to recite an interlocking fastener component made of a biodegradable resin. At least Figures 6-9 show interlocking ~~slide fasteners~~, at least Figures 11, 13, and 15 show interlocking separable fasteners. The

specification describes the slide fastener embodiment illustrated in Figure 6 as comprising coupling elements 4 and a slider 5 for "making and breaking engagement of the coupling elements." (See pg. 21, ln. 9-11.) The specification further describes Figure 11 as "representing the state of engagement between the male fastener member 30 and a female fastener member 40" of a separable fastener. (See pg. 26, ln. 21-23.) With reference to these drawings and the specification as filed, Applicants assert that this engagement of fastener elements and members represents the claimed interlocking of the fastener components without constituting the addition of new matter.

Applicants submit that Obuchi et al. does not anticipate the claimed interlocking fastener components. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); see MPEP § 2131.01. Obuchi et al. discloses molded articles made from a biodegradable resin, including "tying material and other leisure goods." (See col. 9, ln 32.) Applicants submit that the disclosure of a tying material does not either expressly or inherently describe the claimed interlocking fastener component. Components of tying materials, like twine, rope, and fishing line, do not interlock, and Obuchi et al. gives no indication that complex fastener components like those of the present application would constitute the disclosed "tying materials." As a result, Obuchi et al. does not anticipate the pending claims and Applicants respectfully request withdrawal of this rejection.

Applicants further submit that Obuchi et al. does not render obvious the pending claims. In order to prove a *prima facie* case of obviousness, the Examiner must prove

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the existence of three criteria: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings; (2) a reasonable expectation of success; and (3) that the reference teaches or suggests all the claim limitations. See MPEP § 2143. Applicants submit that the rejection maintained by the Examiner does not meet at least the third requirement of a *prima facie* obviousness case.

The Examiner has not established a *prima facie* case of obviousness based on Obuchi et al. because that reference does not teach or suggest all of the claim limitations. As discussed above with regards to the 35 U.S.C. § 102(e) rejection, the amended independent claims recite an interlocking fastener component, yet the "tying material" disclosed by Obuchi et al. does not teach this limitation. Moreover, Obuchi et al. contains no suggestion that the molded articles made from its claimed heat resistant resin would be interlocking or could possess the strength shown by the fastener components of the present application. As a result, a *prima facie* case of obviousness cannot rest upon the disclosure of Obuchi et al. and, therefore, Applicants respectfully request the withdrawal of this rejection.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and the continued examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 11, 2003

By: 

Barry D. Biddle
Reg. No. 44,033

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com